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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL GABRIEL, BRUCE PROBST, and
JEFFREY DIBARTOLOMEO

Appeal 2009-002576
Application 10/627,002
Technology Center 2400

Before ROBERT E. NAPPI, KENNETH W. HAIRSTON, and
THOMAS S. HAHN, *Administrative Patent Judges*.

HAHN, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

Appellants invoke our review under 35 U.S.C. § 134(a) from the final rejection of claims 2-16, 18-21, 23-30, and 32-35. We have jurisdiction under 35 U.S.C. § 6(b). We affirm the Examiner's rejection of these claims.

STATEMENT OF THE CASE

Appellants claim a content player system and method that controls access to content for a plurality of users. A user selects content, and metadata associated with the selected content is compared to a profile including filtering criterion that has both characteristics for permitting and for prohibiting viewing.² Claim 9 is illustrative:

9. A method to control access to content via a player system accessible by a plurality of users, the method comprising:

providing a default profile including at least one filtering criterion, the filtering criterion describing at least one of a characteristic of content permitted for all of the plurality of users and a characteristic of content prohibited for all of the plurality of users;

comparing metadata associated with a selected content and the filtering criterion of the default profile, the metadata including information related to the selected content; and

permitting or denying access to the content based on the comparison, wherein the metadata is associated with the selected content using a URL in connection with the selected content, and wherein the method further comprises obtaining the metadata using the URL, wherein the URL associates the metadata with the selected content.

The Examiner relies on the following prior art references to show unpatentability:³

Kamen	US 2003/0014750 A1	Jan. 16, 2003
alSafadi	US 2003/0088420 A1	May 8, 2003

² See generally Spec. 2:27–3:2; 7:6-9; 9:25–10:2, 9-11, 31-35; Figs. 1, 2.

³ Effective filing dates for these documents precede Appellants' earliest effective filing date and are not at issue.

Ozer	US 6,704,929 A1	Mar. 9, 2004
Horiwitz	US 6,785,901 B1	Aug. 31, 2004

Ozer et al., Tracking Viewing Behavior of Advertisements on a Home Entertainment System, US Patent Application S/N 09/376,631 (filed Aug. 18, 1999) [hereinafter Ozer ‘631].⁴

The Examiner, under 35 U.S.C. § 103(a), rejected:

1. Claims 2-5, 9-14, 16, 19-21, 23-25, 27-30, and 32-35 as unpatentable over Horiwitz and Ozer (Ans. 3-14);
2. Claims 6 and 26 as unpatentable over Horiwitz, Ozer, and alSafadi (Ans. 14-15); and
3. Claims 7, 8, 15, and 18 as unpatentable over Horiwitz, Ozer, and Kamen (Ans. 15-16).

APPELLANTS’ CONTENTIONS

I

Appellants separately argue independent claim 9 for grouped claims 2-5, 9-14, 16, 19-21, 23-25, 27-30, and 32-35 (App. Br. 6-14; Reply Br. 2-4). Accordingly, we select claim 9 as representative for the group. *See* 37 C.F.R. § 41.37 (c)(1)(vii).

The Examiner finds Horiwitz “discloses . . . usage of ‘metadata associated with the selected content’ in conjunction with ratings data derived from an electronic program guide (Figures 4 and 5; Col[] 7, Line 17 – Col 8, Line 38)” (Ans. 4), and the Examiner also acknowledges that Horiwitz “is silent with respect to how the particularly tuned program is associated with its corresponding metadata” (Ans. 4). For the subject matter not taught by Horiwitz, the Examiner finds:

⁴ This document is incorporated by reference into Ozer (col. 14, ll. 14-20). Accordingly, citation to the Ozer patent includes citation to Ozer ‘631.

[Ozer] teaches that viewer programming is monitored and that information such as that associated with ratings “metadata” as derived from the EPG [i.e., electronic program guide] is captured (Col 7, Line 53 – Col 8, Line 23; Col 11, Lines 16-28). . . . The incorporated Ozer et al. (‘631) application in conjunction with identifying programming and associated metadata including ratings, discloses that “metadata is associated with the selected content using a URL in connection with the selected content, and wherein the method further comprises obtaining the metadata using the URL, wherein the URL associates the metadata with the selected content” (Page 15, Line[s] 1-23; Page 16, Line 22 – Page 17, Line 6; Page 17, Line 18 – Page 19, Line 10).

(Ans. 4-5.)

Appellants acknowledge that Horiwitz “describes locking and unlocking of program content” (App. Br. 7), but argue that Ozer and Ozer ‘631 “relate to tracking viewing behavior” (*id.*). Appellants explicitly argue:

At most, Ozer et al., including the Ozer ‘631 application, indicate that data can be referenced using a URL. However, merely because a URL can be used for accessing data stored at an address indicated by the URL does not provide any suggestion to modify the system of Horiwitz et al. to provide for the program content unlocking using metadata accessed via a URL.

(Reply Br. 3.)

II

Appellants also contend that the Examiner erred in rejecting dependent claims 7, 8, 15, and 18 under § 103(a) as being unpatentable over the combination of Horiwitz, Ozer, and Kamen because:

- (A) Appealed method claim 7, which depends from base independent claim 10, covers “providing the selected content on a removable medium” (App. Br. 15; Reply Br. 5).
- (B) Appealed content player claim 18, which depends from base independent claim 21, similarly covers “the selected content [being] provided on a removable media” (*id.*).
- (C) Ozer teaches away by “refer[ing] to data available on an electronic program guide, which would not likely be available for content stored on a removable medium as referred to by Horiwitz et al. and Kamen” (App. Br. 15).
- (D) Further, though, Kamen discloses parental content control and recording, e.g., on a removable media,

Kamen suggests that, once it has been determined that content is unlocked to allow for its local recordation, there is no further reason to perform an unlocking procedure, and indeed no further unlocking procedure is performed Accordingly, even if Horiwitz et al. is modified to include the features taught by Kamen, the resulting combinatory system would not disclose or suggest “a processor configured to compare metadata associated with selected content [provided on a removable media]” as required by claim 18.

(Reply Br. 6 (brackets in original).)

ISSUES

The issues on appeal are:

Whether the Examiner erred under § 103(a) in combining the Horiwitz disclosed content locking and unlocking teachings with the Ozer

teachings for accessing content metadata via a URL in rejecting representative claim 9; and

Whether the Examiner erred under § 103(a) in rejecting claims 7 and 18 because the combination of Horiwitz, Ozer, and Kamen does not teach or suggest the recited limitations.

ANALYSIS

Claims 2-5, 9-14, 16, 19-21, 23-25, 27-30, and 32-35

Appellants argue that the Examiner erred in rejecting representative claim 9, because Ozer, with its teachings for tracking viewer behavior, provides no suggestion for modifying the Horiwitz described locking and unlocking of program content (*see supra* APPELLANTS' CONTENTIONS, I). We disagree.

The Examiner pointedly indicates (Ans. 20) that the Supreme Court has held with respect to combining teachings that it is erroneous to conclude that "a person of ordinary skill attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 420 (2007). In accord, the Examiner reasons, and we concur, that:

The Horiwitz reference is in the field of video distribution and relates to problems associated with controlling viewing of content similar to the instant application. Ozer ('929) is also in the same field of appellant[s'] endeavor namely video distribution systems and it is also reasonably pertinent to the problem in so far as the Ozer ('929) provides 'metadata' (- or electronic program guide data similar to Horiwitz) that can be used for parental control applications as understood in the art.

(Ans. 19.)

We do not find evidence or persuasive argument in the record that it would be beyond the skill of an ordinarily skilled artisan to implement the Ozer taught link to content metadata in Horiwitz, or that such an artisan would not appreciate how the Ozer selection of content metadata could improve Horiwitz. In such circumstances, the Supreme Court has held that “if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.” *KSR*, 550 U.S. at 417.

Based on the record, we, accordingly, will sustain the rejection of representative claim 9, and also the rejection of independent claims 10, 21, 27, 30, 33, and 35 that are not separately argued along with the respective dependent claims that fall with their base independent claims.

Claims 6 and 26

Appellants argue these claims are patentable because their base independent claims 10 and 21 are patentable (App. Br. 14). As addressed *supra*, we will sustain the rejection of claims 10 and 21, and, therefore, we will also sustain the rejection of these dependent claims 6 and 26.

Claims 7, 8, 15, and 18

Appellants argue that the Examiner erred in combining Horiwitz, Ozer, and Kamen to reject dependent claims 7 and 18 because (i) Ozer teaches away by “refer[ing] to data available on an electronic program guide, which would not likely be available for content stored on a removable medium as referred to by Horiwitz et al. and Kamen” (App. Br. 15); and (ii) Kamen suggests unlocking content to allow local recordation without further reason to perform an unlocking procedure (Reply Br. 6). We disagree.

Alternative examples and preferred embodiments do not constitute a teaching away from nonpreferred embodiments. *In re Susi*, 440 F.2d 442 (CCPA 1971). Furthermore, “[t]he prior art’s mere disclosure of more than one alternative does not constitute a teaching away from . . . alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed” *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004).

We, accordingly, are persuaded by the Examiner’s findings that:

Appellants fail to point out any teachings in Ozer (‘929) (or any of the other references) that would dissuade or somehow materially render the combination of references inoperative for “providing the selected content on a removable medium”. Similarly, appellants fail to specifically identify any passages in Ozer (‘929) that would somehow suggest that the existence of EPG information for recorded programs was not in fact available. In fact, Kamen provides evidence regarding the particular usage of EPG information for previously recorded programming that is on removable media such as optical disks (Para. [0007] and [0026] – [0028]).

(Ans. 23.)

Based on the record, we do not find evidence or persuasive argument that (i) the cited references criticize, discredit, or otherwise discourage the solution claimed; (ii) an ordinarily skilled artisan would be unable to recognize the improvement provided by the combination; or (iii) actual application of the combination would be beyond his or her skill.

For the foregoing reasons, we will sustain the rejection of claims 7, 8, 15, and 18.

Appeal 2009-002576
Application 10/627,002

ORDER

The Examiner's decision rejecting claims 2-16, 18-21, 23-30, and 32-35 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(v).

AFFIRMED

babc

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